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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/603,285

06/24/2003

Michael E. Shanahan

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MCCARTER & ENGLISH, LLP
FOUR GATEWAY CENTER
100 MULBERRY STREET
NEWARK, NJ 07102

EXAMINER

NGUYEN, TUAN HOANG

ART UNIT

PAPER NUMBER

2618

MAIL DATE

DELIVERY MODE

06/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/603,285	Applicant(s) SHANAHAN, MICHAEL E.	
	Examiner TUAN H. NGUYEN	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-83 is/are pending in the application.
- 4a) Of the above claim(s) 1-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/23/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/09/2008 has been entered.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 04/23/2008 has been considered by Examiner and made of record in the application file.

3. Claims 1-56 cancelled.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 57, 66, and 75 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 15, 24, 33, 46, 51, 65, and 75 of U.S. Patent No. 7,149,509 in view of Shanahan. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations, i.e., a system for providing a video file to a wireless telephone, the system comprising: a remote computer with access to a database of video files suitable for downloading to the wireless wherein the remote computer is configured to: provide a list of video files in the database to a user of the wireless telephone when the user requests the list of video files; allow the user of the wireless telephone to browse the list of video files; allow the user of the wireless telephone to select a desired video file from the list of video files; and allow the user of the wireless telephone to optionally download a selected video file into the wireless telephone for use as desired by the user of the wireless telephone; wherein the system is configured to confirm the selected video file has been properly received by the wireless telephone, are transparently found in the US Pat. No. 7,149,509.

6. Claims 57, 66, and 75 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 10, 11, 21, and 31 of copending Application No. 10/915866 in view of Shanahan. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations, i.e., a system for providing a polyphonic audio file to a wireless telephone for use as an indicia of an incoming communication, the system comprising: a remote computer with access to a database of polyphonic audio files suitable for downloading to the wireless telephone wherein the remote computer is configured to: provide a list of polyphonic audio files in the database to a user of the wireless telephone when the user requests the list of polyphonic audio files; allow the user of the wireless telephone to browse the list of polyphonic audio files; allow the user of the wireless telephone to select a desired polyphonic audio file from the list of polyphonic audio files; and allow the user of the wireless telephone to optionally download a selected polyphonic audio file into the wireless telephone for future use as an indicia of an incoming communication; wherein the system is configured to confirm the selected polyphonic audio file has been properly received by the wireless telephone, are transparently found in the copending Application No. 10/915866.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 57-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galensky et al. (US PAT. 6,845,398 hereinafter, "Galensky") in view of Isomursu et al. (US PAT. 7,088,990 hereinafter, "Isomursu").

Consider claims 57, 66, and 75, Galensky teaches for providing a video file to a wireless telephone, the system comprising: a remote computer with access to a database of video files suitable for downloading to the wireless telephone (col. 7 lines 25-42) wherein the remote computer is configured to: provide a list of video files in the database to a user of the wireless telephone when the user requests the list of video files (col. 1 lines 20-31); allow the user of the wireless telephone to browse the list of video files (col. 4 line 66 through col. 5 line 9); allow the user of the wireless telephone to select a desired video file from the list of video files (col. 5 lines 31-36); and allow the user of the wireless telephone to optionally download a selected video file into the wireless telephone for use as desired by the user of the wireless telephone (col. 4 lines 42-48).

Galensky does not explicitly show that the system is configured to confirm the selected video file has been properly received by the wireless telephone.

In the same field of endeavor, Isomursu teaches the system is configured to confirm the selected video file has been properly received by the wireless telephone (figs. 8-10, col. 14 line 47 through col. 15 line 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, the system is configured to confirm the selected video file has been properly received by the wireless telephone, as taught by Isomursu, in order to provide the terminal capable of supporting a plurality of applications and having communicating user messages wherein it comprises receiving user messages having data and a header relating to one of applications and addressing the data to a respective application according to header.

Consider claims 58, 67, and 77, Isomursu further teaches the remote computer is further configured to allow the user of the wireless telephone to search the database of video files for a certain video file using title or description information (col. 8 lines 16-44).

Consider claims 59, 68, and 78, Isomursu further teaches configured to allow the user of the wireless telephone to review the selected video file before downloading the selected video file into a programmable memory in the wireless telephone (col. 14 line 47 through col. 15 line 6).

Consider claims 60, 69, and 79, Isomursu further teaches configured to provide the user of the wireless telephone with the option of downloading the selected video file into a programmable memory in the wireless telephone after reviewing the selected video file (col. 14 line 47 through col. 15 line 6).

Consider claims 61 and 70, Isomursu further teaches configured to provide the user of the wireless telephone with the option of editing the selected video file before programming the selected video file into the programmable memory in the wireless telephone (col. 10 lines 32-57).

Consider claims 62, 71, and 80, Galensky further teaches the remote computer is further configured to provide a plurality of lists of video files for browsing by the user of the wireless telephone (col. 4 line 66 through col. 5 line 9).

Consider claims 63, 72, and 81, Galensky further teaches the database is configured to include video files in a format selected from the group comprising MPEG, JPEG, AVI, or DVD format (col. 1 lines 19-27).

Consider claims 64, 73, and 82, Galensky further teaches configured to provide copyright protection for the database of video files to help prevent unauthorized distribution of video files downloaded by the user of the wireless telephone (col. 6 lines 45-58).

Consider claims 65, 74, and 83, the examiner take official notice that these features the communication device is integrated with communication device is notoriously well known in the art in order to successfully download the selected video file.

Consider claim 76, Isomursu further teaches configured to operate in conjunction with a distribution computer to confirm the selected video file/polyphonic audio file has been properly received by the wireless telephone (col. 14 line 47 through col. 15 line 6).

Conclusion

9. Any response to this action should be mailed to:

Mail Stop_____ (Explanation, e.g., Amendment o
After-final, etc.)

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Facsimile responses should be faxed to:

(571) 273-8300

Hand-delivered responses should be brought to:

Customer Service Window

Randolph Building
401 Dulany Street
Alexandria, VA 22313

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan H. Nguyen whose telephone number is (571)272-8329. The examiner can normally be reached on 8:00Am - 5:00Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Maung Nay A. can be reached on (571)272-7882882. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information Consider the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Tuan Nguyen/
Examiner
Art Unit 2618

/Nay A. Maung/
Supervisory Patent Examiner, Art
Unit 2618